

REMARKS

Prior to the February 9, 2005 mailing date of the First Office Action, Applicant prepared and filed via Express Mail on January 25, 2005, a Preliminary Amendment canceling claims 1-32 and providing new claims 33-64. The Preliminary Amendment is indicated as received by the USPTO on the PAIR system. However, the Examiner appears to have examined the claims as pending prior to the filing of the Preliminary Amendment.

Nevertheless, given that the Examiner has acted on the originally-filed claims, Applicant is willing to prosecute claims 1-32 and file the claims submitted in the Preliminary Amendment in a continuation application. Therefore, Applicant respectfully requests that the Examiner respond on the record that the Preliminary Amendment has not been considered and will be withdrawn in furtherance of the prosecution of originally-filed claims 1-32.

In the First Office Action dated February 9, 2005, the Specification is object to and claims 1-23 and 32 are rejected under 35 U.S.C. § 112. Applicant appreciates the Examiner's indication of claims 24 through 31 being allowed.

Specification:

The Specification is objected to at page 13, line 21 and at page 14. As presented in replacement paragraph 42 above, Applicant corrects the typographical error previously calling out slot 68 as slot 38. Applicant likewise corrects page 14 at paragraph 43 which previously provided an inaccurate statement. Correction is hereby presented.

Rejection Under 35 U.S.C. § 112:

Claims 1-23 and 32 stand rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In support of this rejection, the Examiner argues that the cables have not been recited in claim 1 and that the cables are an integral part of the invention without which the structure recited in claim 1 would not be operable. Applicant respectfully traverses this rejection.

The Examiner is presumably utilizing the critical feature requirement discussed at MPEP § 2164.08(c) to reject the claims. As recited therein, “A feature which is taught as critical in a specification and is not recited in the claims should result in a rejection of such claim under the enablement provision section of 35 U.S.C. 112.”

However, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality. See MPEP § 2164.08(c).

At least paragraph 47 in the specification states that the a pair of side drums 26 is operatively connected to the door and a pair of cable drums 30 is operatively connected to the first gas struts 34. Further, the claims as originally filed recite such “operatively connected” language. With respect to claim 1, Applicant claims that the side drums are operatively connected to the door and that the cable drums are operatively connected to the gas struts. Applicant later identifies such operative connections, for example, as a first cable in claim 2.

Such recitation clearly does not describe the cables as critical and therefore preclude Applicant from any other means of connection other than a cable.

Further, Applicant's recitation in claim 1 is a functional description of the mechanical connection. As expressly stated in MPEP 2173.05(g), "There is nothing inherently wrong with defining some part of an invention in functional terms." Further, this section explicitly requires that "A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.

As it is proper for Applicant to functionally identify the "connection" in independent claim 1 and thereafter explicitly identify such connection, for example, as a first cable in claim 2, the original recitation of claim 1 cannot be deemed inoperable not reciting an inoperable embodiment. Further, based upon the functional language of the specification and claim 1, one skilled in the art would clearly understand that a cable or any other similar operable connection could be used to connect the identified members. Therefore, limiting Applicant's claims to the preferred material in the absence of limiting prior art is inappropriate.

Therefore, Applicant respectfully requests that the Examiner withdraw the §112 rejections and indicate claims 1-23 and 32 allowable over the art.

Respectfully submitted,



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